Remarks

Applicant thanks the Examiner for the courtesy extended in granting an interview on March 9, 2005.

Applicant has amended claims 1, 3, 4-8, 17, 18, 20 and 21, and has added new claims 93-99. The amendment to claim 1 was made to clarify the claim language. The amendment to claim 3 was made to introduce the concept of feeding of micro-organisms to *C. elegans* organisms for delivery of vectors that express dsRNA. The amendment is supported in the claims as filed and in the specification, for example at page 3, lines 10-15. The amendments to claims 4, 5, 6, 7, 8, 17, 18, 20 and 21 were made to add dependency from new claim 93.

New claim 93 is directed to embodiments of claim 1 in which the step of introducing said library and/or dsRNA comprises feeding micro-organisms comprising the library and/or dsRNA. New claim 97 is directed to embodiments of claim 93 in which the library is transformed in the micro-organisms. New claim 94 is directed to specific embodiment in which the micro-organisms of claim 93 are adapted to express a transcription factor. New claims 95, 96, 98 and 99 are directed to specific embodiments of micro-organisms. Support for the new claims is found in the claims as filed and in the specification, for example at page 3, lines 10-18.

No new matter has been added.

Rejections Under 35 U.S.C. § 102(e)

The Examiner maintained the rejection of claims 1-15, 17-21, 23, 24, 38-45, 47 and 92 under 35 U.S.C. § 102(e) as anticipated by Fire et al. (US 6,506,559 B1). Applicant respectfully traverses the rejection.

The Examiner asserts that the filing date of the Fire provisional application (US 60/068,562, filed December 23, 1997), serves as the 102(e) date for the Fire patent. Therefore, the Examiner concludes that the Fire patent has an earlier effective filing date than the instant application.

Applicant respectfully disagrees and requests reconsideration on the basis that the disclosure of the Fire provisional application is insufficient as a matter of law under 35 USC § 112, first paragraph, to serve as the 102(e) date with respect to the subject matter claimed by Applicant.

As discussed in the interview of March 9, 2005, the Fire provisional application does not describe the following limitations of Applicant's claims. Regarding claim 1, the Fire provisional application does not describe use of cDNA or genomic libraries (e.g., construction of the libraries and/or introducing the library into *C. elegans*). Regarding claim 3 (and new claim 93), the Fire provisional application does not describe feeding of micro-organisms for delivery of vectors or dsRNA. Regarding claim 38, the Fire provisional application does not describe validating clones identified in yeast two hybrid vector experiments or providing a construct including the DNA encoding the protein identified in two hybrid vector experiments.

Therefore, the Fire provisional application contains no disclosure of several steps of claims 1, 3 and 38. Because all claims depend from one or more of these claims, the Fire provisional application is deficient in disclosing one or more limitations of each of the presently pending claims, and thus does not support that aspect of the Fire patent as asserted against Applicant's claims.

Because the Fire provisional application does not disclose the invention now claimed by Applicant (as is alleged for the Fire patent), the Fire patent should not have the benefit of the Fire provisional application filing date with respect to establishing a prior 102(e) date to serve as an anticipatory reference against the instantly claimed invention.

In view of the foregoing arguments regarding the inadequacy of the Fire patent as a 102(e) reference inasmuch as it depends on the Fire provisional application for an earlier effective filing date, withdrawal of the rejection of the claims under 35 U.S.C. § 102(e) is respectfully requested.

Double Patenting

The Examiner provisionally rejected claims 1-15, 17-21, 23, 24, 38-45, 47, 48 and 92 as unpatentable over claims of copending application 10/057,108 for obviousness-type double patenting.

In view of the reasoned statements made above with respect to the only other rejection of the claims, Applicant respectfully believes that the provisional double patenting rejection will be the only remaining rejection of the claims. Accordingly, pursuant to MPEP 804 I. B. (page 800-19, May 2004 revision), Applicant respectfully requests that the Examiner withdraw the double patenting rejection of the claims at this time.

CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,
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